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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,704	08/14/2000	Roger William Gutwein	7724M	1024

27752 7590 11/05/2002

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EXAMINER

WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
1761	12

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application No.	Applicant(s)
	09/638,704	GUTWEIN ET AL.
	Examiner Anthony Weier	Art Unit 1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(h).

### **Status**

1)  Responsive to communication(s) filed on 18 September 2002.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-54 is/are pending in the application.  
4a) Of the above claim(s) 16-54 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .      6)  Other:

1. Applicant's election with traverse of Group I in Paper No. 11 is acknowledged.

The traversal is on the ground(s) that the groups have not acquired a separate status in the art, and that prosecution of all groups together would eliminate duplication of search efforts. This is not found persuasive because the groups are patentably distinct and are required by statute to be examined separately. There can be examined no more than one invention per application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-7, the use of the terminology "a minimum period of about..." and "a maximum period of about...." is confusing because it is not clear whether a range is being claimed or a specific time period.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 rejected under 35 U.S.C. 102(b) as being anticipated by EP 893065.

EP 893065 discloses preparation of a concentrated coffee extract this packaged and diluted at a later time, for example, as late as 16 weeks (i.e. the shelf life of the extract).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-8 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 893065.

EP 893065 discloses a brew solids of greater than 55% which reads on instant claims 13-15.

The claims differ in that they refer to a maximum time in waiting prior to dilution. EP 893065 is silent concerning times other than 5 weeks and 16 weeks which are related to the shelf-life of the coffee extract. Absent a showing of unexpected results, it would have been obvious to one skilled in the art at the time of the invention to have diluted said extract with the ratio called for as a matter of choice depending on the strength of the coffee desired, amount of coffee desired, etc.

EP 893065 is silent regarding the dilution ratio in the product. However, such determination would have been well within the purview of a skilled artisan, and, absent a showing of unexpected results, it would have been obvious to have attained such dilution ratios as a matter of choice through routine experimental optimization depending on the strength of the brew extract and the consumer's particular tastes regarding coffee.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalenian.

Kalenian discloses preparation of a coffee extract followed by diluting same at some point later. The claims differ in that they recite the particular time before diluting. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed the particular times as called as a matter of choice depending transportation required for completing the dilution step (e.g. extract prepared in one facility and diluted elsewhere).

The claims also differ with regard to the amount of solids in the brew extract as well as the dilution ratio of the final product. However, such determinations are well within the purview of one having ordinary skill in the art, and, absent a showing of unexpected results, it would have been further obvious to have attained such values as a matter of choice through routine experimental optimization depending on the particular strength/taste desired in the final product, the amount of coffee, etc.

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 of copending Application No. 09/638570. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 703-308-3846. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Anthony Weier  
November 4, 2002

  
11/4/02